

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following commentary.

I. Priority Claim

On page 2 of the office action, in the first paragraph, the Examiner omitted priority claim to U.S. Patent Application No. 08/264,581 (now Patent No. 5,585,096), filed June 23, 1994. The present application is a divisional of Serial No. 09/625,509 (now Patent No. 6,699,468), which is a divisional of Serial No. 09/004,511, which is continuation-in-part of Serial No. 08/478,800 (now abandoned), which is a divisional of Serial No. 08/264,581 (now Patent No. 5,585,096). Therefore, the present application benefits from the earliest priority date of June 23, 1994.

II. Claim Rejection under 35 U.S.C. §112, second paragraph

The Examiner rejected claim 20 for alleged indefiniteness by recitation of “G207.” Applicants respectfully traverse the rejection.

The present specification clearly defines viral mutant G207, by reference to its construction, described in paragraphs [0089] and [0091] of the published application, as well as to Applicants’ Figure 2. As paragraph [0091] teaches, G207-1 and G207-2, *etc.* are individual isolates of the identically constructed virus. Keyed to the search terms “G207” and “HSV,” a MEDLINE survey reveals 33 publications, including three reviews, that antedate the filing date of the instant application.

It is apparent, therefore, that “G207” was a well-known denomination of a particular viral construct. For instance, Cinatl *et al.*, *Cancer Research* 63: 1508-514, 2003 (Exhibit A), states that “HSV-1 G207...harbors deletions in both copies of the γ 34.5 gene...[and] an insertion of the *Escherichia coli lacZ* gene in the viral ICP6 gene (UL39)...” (page 1508, right column, first full paragraph). Both a review article by Varghese *et al.*, *Cancer Gene Therapy* 9: 967-78, 2002 (Exhibit B), and a publication by Markert *et al.*, *Gene Ther.* 7: 867-74, 2000 (Exhibit C), describe G207 as a virus having double mutations in the ICP6 and γ 34.5 genes. See Table 1 and the abstract, respectively.

On the present record, there is nothing that contravenes the foregoing evidence of ample clarity attaching to the claim terminology at issue. Accordingly, there is no basis for contending that the skilled person would have any difficulty understanding the metes and bounds of the present claims, Reconsideration and withdrawal of this rejection are respectfully requested, therefore.

III. Claim Rejection under 35 U.S.C. §102(b)

The Examiner rejected claims 16-29 for alleged anticipation by U.S. Patent No. 5,585,096 to Martuza *et al.* and by WO 96/00007 to Martuza *et al.*, respectively. Applicants respectfully traverse the rejection.

As discussed in section I, *supra*, the present application has an effective filing date, June 23, 1994, which antedates the publication of the '007 reference. Accordingly, neither of the cited reference qualifies as §102 art in this context. Applicants request, therefore, that the Examiner withdraw the subject rejection.

IV. Double Patenting Rejections

The Examiner provisionally rejected claims 16-29 over co-pending applications serial No. 10/788,410 (claims 16-29) and serial No. 11/097,391 (claims 35-39 and 43-46), respectively. Since the rejections are provisional, Applicants choose to defer action until there is an actual rejection made. Applicants will consider to file a terminal disclaimer upon indication of allowance of the instant claims or the co-pending claims.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account

Atty. Dkt. No. 066683-0198
U.S. Serial No. 10/788,410

No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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